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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,586	11/09/2001	Toshiro Tsuchida	P21332	5812
7055	7590	01/21/2004	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			MARKS, CHRISTINA M	
			ART UNIT	PAPER NUMBER
			3713	8
DATE MAILED: 01/21/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,586

Applicant(s)

TSUCHIDA ET AL.

Examiner

C. Marks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Specification

The objection to the specification for incorporation by reference to foreign material has been withdrawn due to the removal of the statement in the amendment filed 10 November 2003.

Oath/Declaration

The objection to the oath/declaration has been withdrawn due to the filing of a corrected oath, which properly refers to the application by filing number as well as contains both signatures of the inventors received with the amendment filed 10 November 2003.

Claim Rejections - 35 USC § 112

The rejection of claims 4-5, 10-11, 16-17 and 22-23 under 35 U.S.C. §112 have been withdrawn due to the correction of the deficiencies in the amendment filed 10 November 2003.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims recite the limitation "program of a video game" which has been found to be non-statutory because it is not embodied on a tangible medium. As per MPEP §2106 IV, computer program claimed as computer listings *per se* are not physical things. They are neither computer components nor statutory processes, as they are not "acts being performed." Such computer programs do not define any structural and functional interrelationships between the computer

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program and other claimed elements of a computer that permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element that defines structural and functional interrelationships between the computer program and the rest of the computer that permit the computer program's functionality to be realized and is thus statutory.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 7-9, 13-15, and 19-21 are rejected under 35 U.S.C. 103(a) as being anticipated by Ohnuma et al. (US Patent No. 6,375,571).

Ohnuma et al. disclose control method relating to a computer-readable recording medium having a program of a video game recorded therein (FIG 6) wherein player characters are assigned predetermined parameters in the form of items that can be changed when the player character defeats an enemy character (FIG 15). This computer-readable recording medium is in the form of a gaming apparatus and the program inherently controls the processing that occurs within the device.

Upon execution, the computer will compare an amount of damage inflicted on the enemy character by the player character each time the player character attacks, including before and immediately before the player character defeats the enemy (Column 15, lines 50-57). Each enemy character has a threshold value set in the form of hit points. When the amount of damage done by the player character is not equal to the threshold value, the player parameter is changed by a first value (Column 15, lines 51-55). When the amount of damage is at least equal to the threshold value and the enemy is defeated, the player parameter is changed by a second value (Column 15, lines 55-59).

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The player parameter is associated with the process of gaining items based upon the result of the battle (Column 15, lines 57-59). When the amount of damage is less than the threshold value, Ohnuma et al. do not disclose the exact result but it is inferred that the player parameters relating to the number of items stored for the player is raised by a first value equal to zero (Column 15, lines 48-51). When the amount of damage is at least equal to the threshold value, Ohnuma et al. disclose that the parameter is raised by a second value, wherein the player can acquire certain items for the win (Column 5, lines 55-59) thus increasing the number of items is increased. Therefore, this parameter can be directly associated with the number of items acquired by the player for the defeat.

Ohnuma et al. disclose a method with different awards for beating and not beating an enemy and the threshold only measures if the player actually defeats an enemy and each player that passes the threshold value is presented with the same parameter, regardless of how well they passed the value. The threshold does not allow a player to achieve greater awards based on how badly the enemy was beat.

Final Fantasy VIII discloses an alternate method of awarding players in a battle situation. Final Fantasy VIII allows a threshold value to be set for a battle against the monsters of the Fire Cavern. The players have a parameter of a SeeD ranking associated with the threshold value and used with the monsters of the Fire Cavern. Once the player defeats the enemies and makes their way through, their performance is compared to the threshold value and the quicker they made it through the more the parameter is changed. If they beat all the enemies but did not do as well against the threshold value, the less the parameter is changed. Thus, even though in both instances the player beat the enemy, the player who did it better is awarded more points.

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The teachings of Final Fantasy VIII obviate to a skilled artisan that a player can be awarded not only for beating an enemy, but also for how they do it. Ohnuma et al. does not embrace this concept. A skilled artisan would also understand that a number of ways besides time could be used to establish how well a monster is beat, including for example, how many turns it took, what weapons were used, how much the monster was beat by, or any of the other well-known features of a fighting game. Therefore, it would have been obvious to a skilled artisan to apply the teachings of Final Fantasy VIII to Ohnuma et al. in awarding players for how well they defeat the monster. Though Final Fantasy VIII relates the parameter to time, one of ordinary skill in the art would understand as disclosed above that other parameters could easily be chosen while keeping with the intent of the teachings. Thus, when applying to Ohnuma et al., it would be obvious to use an alternate parameter such as to keep track of how soundly the monster was beat. This would be especially obvious since the awards of Ohnuma et al. are based on this factor, not on time. Currently Ohnuma et al. has the restriction of a reward only upon beating a monster. Therefore, by using the teachings of Final Fantasy VIII, one of ordinary skill in the art would find it obvious to use concept of awarding players for not only beating a monster, but for how well they do it. One of ordinary skill in the art would be motivated to do this in order to keep with the scoring methods of Ohnuma et al. but also to reward players for more than just successful defeats, thus, more advanced players would feel they are truly being judged and would get more satisfaction than the current method of Ohnuma et al. which awards all players who defeat a monster equally, thus alienating the success of those who not only beat the monster, but do it especially well.

Further applying these teachings to Ohnuma et al. which awards players with items, one of ordinary skill in the art would find it obvious when adhering to the Final Fantasy VIII teachings

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that a win with greater damage would result in better prizes, thus changing the item parameter by a greater value for greater wins.

Claims 4-5, 10-11, 16-17 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohnuma et al. (US Patent No. 6,375,571) in view of Kondo et al. (US Patent No. 6,347,993).

What Ohnuma et al. and Final Fantasy VIII disclose, teach, and/or suggest has been discussed above and is incorporated herein.

Similar to Final Fantasy VII disclosed above, Kondo et al. also teaches of a battle method wherein a player character engages with an enemy character. A time threshold is set as the time it would take to defeat the enemy character. The player is also awarded points to help their character develop for each segment of time passed with the number of points being more the closer the player gets to the threshold value of defeating the character (see for example Column 21, lines 13-40). A first number of points is stored if the player performs less than the threshold value and a second number of points is stored if the player meets the threshold. The points obtained by the character are used to supplement parameters to support the character development, growth, and strength.

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the teachings of Kondo et al. into the system of Ohnuma et al. By applying these teachings, the player character would be rewarded points for their effort in battling the character, not just for defeating the character. One of ordinary skill in the art would be motivated to make this incorporation, as it would provide motivation to the players, as it would reward them for good attempts, not just for victory. This would keep the players encouraged as well as allow them to slowly develop their character to the point where they will be able to defeat the enemy

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character, thus promoting play and keeping the interest of the player as they would feel more successful as they would be awarded more often. Further, it would have been an alternative design alternative to award the players different types of items based upon the points obtained as disclosed by Kondo et al.

One of ordinary skill in the art understands that in a role-playing game as disclosed by both Kondo et al and Ohnuma et al., it is notoriously well known in the art that magic or other weapon items can be obtained by reaching a certain point level or acquisition factor. It would have been obvious to one of ordinary skill in the art that as a design alternative to awarding the player points based upon nearness to the threshold value as disclosed by Kondo et al., the players could be awarded different items (as opposed to different points) based upon how close they came to defeating the character. This would be synonymous with the awarding of items disclosed by Ohnuma et al.

Likewise, by awarding points as currently disclosed by Kondo et al., the gaming system is essentially awarding a probability of acquiring an item, as it is disclosed above that it is notoriously well known in the art that acquisition factors are used in awarding items wherein higher acquisition factors are associated with more powerful items, and by awarding points, the system would be essentially naming the probability value as the points awarded would be a probability function of the total points needed to acquire the item.

Claims 6, 12, 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohnuma et al. (US Patent No. 6,375,571).

What Ohnuma et al. disclose has been discussed above and is incorporated herein.

Though Ohnuma et al. disclose information can be communicated over a network (Column 12, lines 55-57), Ohnuma et al. do not specifically disclose play can commence over

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the network. However, it is notoriously well known in the art and understood by one of ordinary skill in the art that role-playing games can be played over a network wherein players can interact with numerous players from around the world. This feature increases excitement in the game, as there are an endless number of enemies to battle and friends to make. Such a feature would be obvious to Ohnuma et al.

Response to Arguments

The Applicant's argument that none of the references disclose changing a parameter based on how soundly the enemy is defeated is not persuasive as it provides no factual support for the claim and is thus conclusionary.

Regarding the Applicant's argument that Ohnuma et al. does not use a parameter relating to stored items, the Examiner respectfully disagrees. The parameter awarded to the player for a defeat does indeed include items as Ohnuma et al. state that if the monster is defeated, the process of gaining items (parameters) is performed.

Regarding Applicant's argument that the parameter does not change by an amount based upon the kill, the argument is rendered moot in view of the new grounds of rejection presented above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period


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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.


cmm
January 13, 2004



**MICHAEL O'NEILL
PRIMARY EXAMINER**